

REMARKS

In the Office Action of March 14, 2006, a Restriction Requirement was imposed under 35 U.S.C. § 121 as follows, requiring election of one of the following groups for prosecution on the merits, each of which is alleged to encompass a separate invention:

- I. Claims 1-12, drawn to compounds and compositions classified in classes 544, 546, 548, 514 and numerous subclasses;
- II. Claims 13-15, 33-35, 53-55, 73-75 and 90-93 drawn to uses of compositions classified in class 514 and numerous subclasses;
- III. Claims 16-19, 36-39, 56-59, and 76-79 drawn to a method of treating pain with the compounds classified in class 514;
- IV. Claims 20, 40, 60, and 80-84 drawn to a method for stimulating receptor function classified in class 514;
- V. Claims 21-32 and 85 drawn to compounds and compositions classified in classes 544, 546, 548, 514 and numerous subclasses;
- VI. Claims 41-52 drawn to compounds and compositions classified in classes 514, 546, 548, 514 and numerous subclasses;
- VII. Claims 61-72 drawn to compounds and compositions classified in classes 544, 546, 548, 514 and numerous subclasses;
- VIII. Claims 86-89 drawn to a kit composition classified in class 514 and several subclasses;
- IX. Claims 94-109 drawn to a method of treating diarrhea with the compounds classified in class 514; and
- X. Claims 110 and 111 drawn to compounds classified in class 546 and several subclasses.

At the outset, Applicant notes an inconsistency in the assignment of a claim to the Groups identified above. Claim 85 has been assigned to Group V, which is directed toward compounds and compositions classified in classes 544, 546, 548, 514 and numerous subclasses. Claim 85, however, is directed toward a method for preparing a composition comprising admixing a compound or a pharmaceutically acceptable salt of the compound of claim 1, 21, 41, or 61, and a pharmaceutically acceptable carrier or excipient. Accordingly, the method of claim 85 does not appear to fall within any of the Groups identified above. Applicant respectfully requests clarification.

Applicant respectfully traverses the Restriction Requirement. Specifically, Applicant requests that the requirement be modified to the extent that Group I (claims 1-12), is combined with claims 13-15 and 90 of Group II, claim 16-19 of Group III, claim 20 of Group IV, claims 81-84 (in part; *i.e.* to the extent that claims 81-84 depend on claim 20) of Group IV, claim 85 (in part; *i.e.* to the extent that claim 85 depends on claim 1) of Group V, claim 86 of Group VIII, and claims 94-97 of Group IX, be combined and examined together in the instant application.

Applicant submits that a search of the art for the compounds of Formulae Ia as recited in independent claim 1 will also inevitably yield the prior art, if any, for the methods of treatment or receptor stimulation using a compound of Formula Ia (claims 16-19, 20, 81-84, and 94-97), for kits and compositions comprising a compound of Formula Ia (claims 13-15, and 86), as well as for a method for preparing a composition comprising a compound of Formula Ia (claim 85). That is, a search of the prior art for the subject matter of Group I, *viz* a the compounds of Formulae Ia, would encompass not only art disclosing such compounds (claims 1-12) but also art disclosing the subject matter of claims 13-20, 81-86, 90, and 94-97, as well.

Applicant further submits that, under M.P.E.P. § 803, the subject matter of claims 1-20, 81-86, 90, and 94-97 can be examined together in a single application without imposing a serious burden on the Examiner. M.P.E.P. § 803 (Eighth Edition, Revision 3, August 2005) provides that:

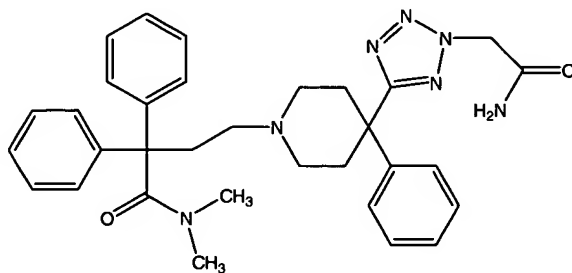
If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.

Accordingly, Applicant respectfully requests that the Restriction Requirement under 35 U.S.C. § 121 be modified so that claims 1-20, 81-86, 90, and 94-97, can be examined together in the instant application.

In order to be fully responsive to the outstanding Restriction Requirement, Applicant hereby provisionally elects, with traverse, Group I, which, as initially set forth in the Office Action of March 14, 2006, includes claims 1-12 drawn to compounds and compositions of compounds of Formulae Ia.

In addition to the election of one of the above-identified Groups, Applicant is also required to elect a single compound and to provide a listing of all claims readable thereon.

In response Applicant elects the following compound, which is designated as compound **A**FE at page 21, line 7, and at page 113, lines 2-4 of the specification as filed.



AFE

Compound **A**FE is a compound of Formula I(a) of claim 1 in which Ar¹ and Ar² are both phenyl; m = 1; p = 0; q = 0; G is -CH₂C(O)NH₂; and R¹ is -C(O)N(CH₃)₂.

Claims 1-20, 81-86, 90, and 94-97 read on the elected species, compound **A**FE.

This provisional election is made without prejudice to Applicant's right to pursue the non-elected subject matter in one or more related applications. Attorneys for Applicant retain the right to petition from this Restriction Requirement under 37 C.F.R. § 1.144.

CONCLUSION

Applicant respectfully requests that the present remarks be entered and made of record in the instant application, and that the Restriction Requirement be modified accordingly. An early allowance of the instant application is earnestly requested. If any issues remain in connection herewith, the Examiner is respectfully invited to telephone the undersigned to discuss the same.

Applicant believes that no fee is due for this response. However, if the Commissioner should determine that a fee is due, please charge the required amounts to Jones Day Deposit Account No. 50-3013.

Respectfully submitted,

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